

**Amendment and Response**

Applicant: Christian L. Struble

Serial No.: 09/888,350

Filed: June 21, 2001

Docket No.: 10005647-1 (H303.203.101)

Title: ELECTRONIC DOCUMENT SENDER SYSTEM AND METHOD WITH EXTERNAL ADDRESS ACCESS

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**REMARKS**

The following remarks are made in response to the Office Action mailed October 5, 2004. Claims 1-24 were rejected. With this Response, claims 1 and 20 have been amended. Claims 1-24 remain pending in the application and are presented for reconsideration and allowance.

**Claim Rejections under 35 U.S.C. § 103**

Claims 1-2, 4, 6, 10, 12-14, 18-21, 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cotte et al. U.S. Patent No. 5,499,108 (herein Cotte) in view of Cho U.S. Patent No. 5,995,593 (herein Cho).

Applicant's independent claim 1 specifies a method of document scanning. The method comprises wirelessly communicating a request, initiated by a mobile computing device, to a scanner to image a paper document into an electronic document and to send the electronic document to a document server identified by the mobile computing device. The paper document is imaged with the scanner to produce the electronic document, and the electronic document is sent from the scanner to the identified document server.

Cotte discloses an input device for a computer system to enable a single port to be shared on a host computer by the input device (e.g. a scanner) and a FAX modem. See Cotte at Column 1, lines 12-15. As shown in Figure 10, a host CPU 110 is directly connected to the input device/scanner 114, via link 112, which is in turn directly connected to fax modem 118, via link 116. A passthrough data path 124 resides in input device 114. See Cotte at Column 8, lines 12-31.

Cotte fails to disclose a mobile computing device that initiates a wireless communicate request to a scanner to image a document. The Office Action admits this deficiency in Cotte. Moreover, Cotte apparently does not disclose any wireless communication between a mobile computing device and a scanner, nor sending an electronic document from the scanner to a document server identified by the mobile computing device.

Cho fails to cure the deficiencies of Cotte. Cho discloses a wired/wireless communication system including, among other things, a computer terminal 100 having a transceiver for wireless communication with peripherals 400 such as a scanner 410 and other

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devices. See Cho at Column 4, lines 11-15. Computer terminal 100 can wirelessly communicate with a second computer terminal 200, via transceivers 110, 210 respectively, via telephone network 300. Cho at Figure 1, Column 3, lines 39-67.

In contrast, Applicant's claimed mobile computing device is distinct and separate from a document server to which the scanner sends an electronic document. Cho does not disclose a mobile computing device, distinct from its computer terminal 100 that is in wireless communication with scanner 410.

Moreover, Cho does not disclose a mobile computing device that wireless communicates a request to a scanner to identify a document server to which electronic documents are to be sent, as claimed by Applicant. Cho does not disclose a mobile computing device that initiates a request to a scanner, via wireless communication, to image a paper document into an electronic document, as claimed by Applicant. Finally, Cho does not disclose sending the electronic document to the document server identified by the mobile computing device, as claimed by Applicant.

Neither Cotte nor Cho disclose a method of scanning including a wireless communication request from a mobile computing device to a scanner to image a paper document and to send an image of the paper document as an electronic document to a document server identified by the mobile computing device, and then obtaining the image, and sending the electronic document from the scanner to the identified document server. Accordingly, one could not combine Cotte in view of Cho and arrive at the invention of independent claim 1.

For these reasons, Cotte and Cho, alone or in combination, fail to teach or suggest Applicant's independent claim 1. Accordingly, Applicant's believe that independent claim 1 is allowable over Cotte and Cho. Claims 2-3 are believed to be allowable based on their dependency from independent claim 1.

For substantially the same reasons as presented for patentability of claim 1, Cotte and Cho fail to disclose Applicant's amended independent claim 20 which is directed to a computer readable medium having computer-executable instructions for performing a method of document scanning -- the method including substantially the same limitations as claim 1. For these reasons, Cotte and Cho fail to teach or suggest amended independent claim 20, and

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therefore Applicant's amended independent claim 20 is patentable and allowable over Cotte and Cho. Claims 21-22 are believed to be allowable as well based on their dependency from claim 20.

Applicant's independent claim 4 is patentable over Cotte and Cho for substantially the same reasons presented for the patentability of independent claim 1. Neither Cotte nor Cho disclose a method of wirelessly activated document transportation including a wireless sending a request from a mobile computing device to a scanner to image a paper document at the scanner, then obtaining the image to produce an electronic document, and then sending the electronic document from the scanner to a document server at an electronic address identified by the mobile computing device, as claimed by Applicant. Accordingly, one could not combine Cotte in view of Cho and arrive at the invention of independent claim 4.

For these reasons, Cotte and Cho, alone or in combination, fail to teach or suggest Applicant's independent claim 4. Accordingly, Applicant's believe that independent claim 4 is allowable over Cotte and Cho. Claim 5 is believed to be allowable based on its dependency from independent claim 4.

For substantially the same reasons as presented for patentability of claim 4, Cotte and Cho fail to disclose Applicant's amended independent claim 23 which is directed to a computer readable medium having computer-executable instructions for performing a method of wirelessly activated document transportation -- the method including substantially the same limitations as claim 4. For these reasons, Cotte and Cho fail to teach or suggest amended independent claim 23, and therefore Applicant's amended independent claim 23 is patentable and allowable over Cotte and Cho.

Applicant's independent claim 6 is patentable over Cotte and Cho for substantially the same reasons presented for the patentability of independent claim 1, as Cotte does not disclose a mobile computing device wirelessly sending a scanner address and a document identifier to a document server, as part of a request to obtain an electronic document from the scanner, as claimed by Applicant. Instead, as previously explained Cotte is directed to an input device facilitating sharing of a single computer port for a scanner and a FAX modem. Cho fails to cure this deficiency, as Cho is directed to a wired/wireless communication

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system that lacks a mobile computing device for wirelessly communicating with a document server to cause document imaging at a scanner.

For these reasons, neither Cotte nor Cho disclose a method of remotely activated scanning including wirelessly sending from a mobile computing device to a document server a scanner address and a document identifier with a request to obtain an electronic document from the scanner, and querying the scanner with the document server using the scanner address and the document identifier to request the electronic document, and sending the electronic document from the scanner to the document server. Accordingly, one could not combine Cotte in view of Cho and arrive at the invention of independent claim 6.

For these reasons, Cotte and Cho, alone or in combination, fail to teach or suggest Applicant's independent claim 6. Accordingly, Applicant's believe that independent claim 6 is allowable over Cotte and Cho. Claims 7-9 are believed to be allowable based on their dependency from independent claim 6.

For substantially the same reasons as presented for patentability of claim 6, Cotte and Cho fail to disclose Applicant's amended independent claim 24 which is directed to a computer readable medium having computer-executable instructions for performing a method of remotely activated scanning -- the method including substantially the same limitations as claim 6. For these reasons, Cotte and Cho fail to teach or suggest amended independent claim 24, and therefore Applicant's amended independent claim 24 is patentable and allowable over Cotte and Cho.

Applicant's independent claim 10 is patentable over Cotte and Cho for substantially the same reasons presented for the patentability of independent claim 1, as neither Cotte nor Cho disclose a document scanner including a communication module configured for wirelessly receiving an imaging request from a mobile computing device and for sending the electronic document to a document server based on the imaging request from the mobile computing device. Cotte is directed to port sharing of a computer – not wireless communication with a mobile computing device. Cho is directed to a communication system but lacks a scanner adapted to receive image requests from a mobile computing device for sending to document server. Accordingly, one could not combine Cotte in view of Cho and arrive at the invention of independent claim 10.

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For these reasons, Cotte and Cho, alone or in combination, fail to teach or suggest Applicant's independent claim 10. Accordingly, Applicant's believe that independent claim 10 is allowable over Cotte and Cho. Claim 11 is believed to be allowable based on its dependency from independent claim 10.

Applicant's independent claim 12 is patentable over Cotte and Cho for substantially the same reasons presented for the patentability of independent claim 1, as neither Cotte nor Cho disclose a scanning system including a document server and a scanner including a communication module configured for wirelessly receiving an imaging request from a mobile computing device and for sending the electronic document to a document server based on the imaging request from the mobile computing device. Cotte is directed to port sharing of a computer – not wireless communication with a mobile computing device. Cho is directed to a communication system but lacks a scanner adapted to receive image requests from a mobile computing device for sending to document server. Accordingly, one could not combine Cotte in view of Cho and arrive at the invention of independent claim 12.

For these reasons, Cotte and Cho, alone or in combination, fail to teach or suggest Applicant's independent claim 12. Accordingly, Applicant's believe that independent claim 12 is allowable over Cotte and Cho. Claim 13 is believed to be allowable based on its dependency from independent claim 12.

Applicant's independent claim 18 is patentable over Cotte and Cho for substantially the same reasons presented for the patentability of independent claim 1, as neither Cotte nor Cho disclose a wireless document scanning system including a document server and a scanner including a communication module configured for wirelessly receiving an imaging request from a mobile computing device and for sending the electronic document to a document server based on the imaging request from the mobile computing device. Cotte is directed to port sharing of a computer – not wireless communication with a mobile computing device. Cho is directed to a communication system but lacks a scanner adapted to receive image requests from a mobile computing device for sending to document server. Finally, since neither Cotte nor Cho disclose a mobile computing device, neither Cotte nor Cho disclose the wireless communication features of a mobile computing device relative to a

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scanner and a document server, as claimed by Applicant. Accordingly, one could not combine Cotte in view of Cho and arrive at the invention of independent claim 18.

For these reasons, Cotte and Cho, alone or in combination, fail to teach or suggest Applicant's independent claim 18. Accordingly, Applicant's believe that independent claim 12 is allowable over Cotte and Cho.

Applicant's independent claim 19 is patentable over Cotte and Cho for substantially the same reasons presented for the patentability of independent claim 1, as neither Cotte nor Cho disclose a wireless document scanning system including a document server and a scanner including a communication module configured for wirelessly receiving an imaging request from a mobile computing device and for sending the electronic document to a document server based on the imaging request from the mobile computing device. Cotte is directed to port sharing of a computer – not wireless communication with a mobile computing device. Cho is directed to a communication system but lacks a scanner adapted to receive image requests from a mobile computing device for sending to document server.

Finally, since neither Cotte nor Cho disclose a mobile computing device, neither Cotte nor Cho disclose the wireless communication features of a mobile computing device relative to a scanner and a document server, as claimed by Applicant. Accordingly, one could not combine Cotte in view of Cho and arrive at the invention of independent claim 19.

For these reasons, Cotte and Cho, alone or in combination, fail to teach or suggest Applicant's independent claim 19. Accordingly, Applicant's believe that independent claim 12 is allowable over Cotte and Cho.

Accordingly, Applicant respectfully requests that the above 35 U.S.C. § 102(e) rejection to claims 1-2, 4, 6, 10, 12-14, 18-21, and 23-24 based on Cotte and Cho be reconsidered and withdrawn, and that these claims be allowed.

In the Office Action, claims 3, 5, 7-9, 13-17, 22 were rejected under 35 U.S.C. 103(a) as being unpatentable over Cotte and Cho in view of Browning U.S. Patent No. 6,081,629 (herein Browning).

Dependent claim 3 is believed to be allowable based on its dependency from independent claim 1, which is believed to be allowable for the reasons previously presented

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regarding Cotte and Cho. Dependent claim 5 is believed to be allowable based on its dependency from independent claim 4, which is believed to be allowable for the reasons previously presented regarding Cotte and Cho. Dependent claims 7-9 are believed to be allowable based on their dependency from independent claim 8, which is believed to be allowable for the reasons previously presented regarding Cotte and Cho. Dependent claim 13 is believed to be allowable based on its dependency from independent claim 12, which is believed to be allowable for the reasons previously presented regarding Cotte and Cho.

Regarding dependent claims 3, 5, 7-9, and 13, Browning fails to cure the deficiencies of Cotte and/or Cho, as Browning is directed to a handheld scanner. Accordingly, Applicant's believes that claims 3, 5, 7-9, and 13 are patentable and allowable over Cotte, Cho and/or Browning.

Applicant's independent claim 14 is patentable over Cotte and Cho for substantially the same reasons presented for the patentability of independent claim 12, as neither Cotte nor Cho disclose a scanning system including a document server, a scanner, and a mobile computing device, wherein the scanner includes a communication module configured for sending an electronic document (an image of a paper document) to a document server and wherein the mobile computing device includes a wireless communication module configured to send a request to the scanner to image a paper document and configured to identify to the scanner the address of the document server. Cotte is directed to port sharing of a computer – not wireless communication between a scanner and a mobile computing device for interaction with a document server. Cho is directed to a communication system but lacks a scanner adapted to send an electronic document to a document server at an address identified by a mobile computing device. Accordingly, one could not combine Cotte in view of Cho and arrive at the invention of independent claim 14.

Browning fails to cure the deficiencies of Cotte and/or Cho, as Browning is directed to a handheld scanner and not a system with distinct elements of a scanner, mobile computing device, and document server that interact in the manner claimed by Applicant.

For these reasons, Cotte and Cho, alone or in combination, fail to teach or suggest Applicant's independent claim 14. Accordingly, Applicant's believe that independent claim

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14 is allowable over Cotte and Cho. Claims 15-17 are believed to be allowable based on their dependency from independent claim 14.

Accordingly, Applicant respectfully requests that the above 35 U.S.C. § 102(e) rejection to claims 3, 5, 7-9, 13-17, and 22 based on Cotte, Cho, and Browning be reconsidered and withdrawn, and that these claims be allowed.

**CONCLUSION**

In view of the above, Applicant respectfully submits that pending claims 1-24 are in form for allowance and are not taught or suggested by the cited references. Therefore, reconsideration and withdrawal of the rejections and allowance of claims 1-24 is respectfully requested.

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The Examiner is invited to contact the Applicant's representative at the below-listed telephone numbers to facilitate prosecution of this application.

Any inquiry regarding this Amendment and Response should be directed to either Robert Sismilich at Telephone No. (858) 655-8329, Facsimile No. (858) 655-5859 or Paul S. Grunzweig at Telephone No. (612) 767-2504, Facsimile No. (612) 573-2005. In addition, all correspondence should continue to be directed to the following address:

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Respectfully submitted,

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**CERTIFICATE UNDER 37 C.F.R. 1.8:** The undersigned hereby certifies that this paper or papers, as described herein, are being deposited in the United States Postal Service, as first class mail, in an envelope address to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 17<sup>th</sup> day of December, 2004.

By   
Name: Paul S. Grunzweig